

REMARKS

Claims 1-13 are currently pending. The Examiner has rejected claims 1-10 as claiming the same invention as that of claims 1-10 of U.S. Patent Application No. 10/702,793. The Examiner has also rejected claims 1-2, 4-6, and 8-9 as being unpatentable over U.S. Patent No. 6,851,859 to Takehana. The following remarks are considered by applicant to overcome each of the Examiner's outstanding rejections. An early Notice of Allowance is therefore requested.

I. Examiner's Rejections Under 35 U.S.C. § 112

Examiner has provisionally rejected claims 1-10 as double patenting under 35 U.S.C. § 101 for claiming the same invention as that of claims 1-10 of U.S. Patent Application No. 10/702,793 to Aiello et al. ("Aiello"). Examiner asserts that the conflicting claims are not patentably distinct from each other because they differ only with respect to matters of wording or verbal surplusage as to any differences in wording. However, Applicants respectfully assert that Examiner has improperly applied the double patenting rejection. The MPEP states that "[b]efore consideration can be given to the issue of double patenting, there **must be some common relationship of inventorship and/or ownership** of two or more patents or applications." MPEP § 804, P. 800-11 (8th ed. rev. 2, May 2004) (emphasis added). The inventors for Applicants' application are Yasushi Mizusaki and Hisaya Nakagawa, while the inventors for U.S. Patent Application No. 10/702,793 are Anthony Joseph Aiello, Klaus Dieter Kloppel, Paco Gregor Flores, and Alex Gredinberg. Applicants' application is assigned to Sankyo Seiki Mfg. Co., Ltd., while U.S. Patent Application No. 10/702,793 is assigned to Seagate Technology LLC. Since there is no common relationship of inventorship or ownership between the two applications, Examiner's double patenting rejection is improper and should be removed.

Furthermore, Applicants respectfully assert that even if there were some common relationship of inventorship or ownership between the two applications, Applicants' claims are patentably distinct from claims 1-10 of Aiello. Applicants' claims as amended contain four independent claims, three independent apparatus claims (claims 3, 10, and 11) and one independent method claim (claim 7). All of the independent apparatus claims include a limitation that one of the bearing member and the shaft member is formed of, or includes, a "porous metal sintered body." The independent method claim also contains a limitation relating to a "porous metal sintered body." Aiello never discloses, let alone claims, a porous metal sintered body. This makes Applicants' claims patentably distinct from Aiello.

In addition, claims 3 and 11 contain a limitation that "the metal sintered body is filled with a lubricating resin," and claim 10 contains a limitation that the hollow holes of the porous metal sintered body "contain a lubricating resin." Similarly, claim 7 contains a method limitation "coating a lubricating resin on the bearing surface of the metal sintered body." Aiello never discloses, let alone claims, a lubricating resin. This makes Applicants' claims patentably distinct from Aiello.

There is no common relationship of inventorship or ownership between the two applications. Moreover, Applicants' claims are patentably distinct from Aiello. Therefore, Applicant respectfully asserts that Examiner's double patenting rejection is improper and requests that the rejection be removed.

II. Examiner's Rejections Under 35 U.S.C. § 102

Examiner has rejected claims 1-2, 4-6, and 8-9 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,851,859 to Takehana et al. ("Takehana"). Applicants have canceled claims 1, 2, 5, 6, 8, and 9. Claims 3, 4, 7, and 10 are amended. No new matter is

presented. In view of the above amendments, Applicants respectfully request the reconsideration of claims 3, 4, 7, and 10.

Claims 3, 4, 7, and 10 recite patentable subject matter. Specifically, Takehana fails to teach or suggest features recited in claims 3, 7, and 10. Additionally, Applicants have added a new claim 11 by rewriting old claim 5 to include the limitations from both old claims 2 and 3. Applicants have added two more claims, claims 12 and 13, both of which are dependant from claim 11. As claim 3 is allowable, so must be claims 11, 12, and 13.

As related above in the discussions for each individual claim, it is respectfully asserted that the Examiner has failed to show that Applicants' claims are not patentable distinct from Aiello. It is respectfully asserted that claims 3, 4, 7, and 10-13 are not anticipated by Takehana. Therefore, Applicants respectfully assert that the Examiner has not satisfied the Examiner's burden of establishing a prima facie case of double patenting under 35 U.S.C. § 101 or anticipation under 35 U.S.C. § 102 with respect to claims 3, 4, 7, and 10-13.

Based upon the above remarks, Applicant respectfully requests reconsideration of this application and its early allowance. Should the Examiner feel that a telephone conference with Applicants' attorney would expedite the prosecution of this application, the Examiner is urged to contact him at the number indicated below.

Respectfully submitted,

EL:JWT

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